

REMARKS

Claims 16-21 remain pending in the application, with Claims 1-15 and 22 being canceled without prejudice or disclaimer as being directed to non-elected species. Claims 16-21 are amended to be clearer.

Based on the above Amendment and the following Remarks, Applicant respectfully requests that the examiner reconsider all outstanding objections and rejections, and withdraw them.

Objection to the Abstract and Title

Applicant has amended the Abstract and title in a manner believed to comply with PTO regulations and the examiner's requirements. Accordingly, reconsideration and withdrawal of the objections are respectfully requested.

Rejection under 35 U.S.C. § 101

The examiner has rejected Claims 16-21 as being non-statutory subject matter, in particular an abstract idea.

Applicant has amended independent Claim 16 to more clearly define the invention in terms other than those of what the examiner perceives as manipulation of an abstract idea.

More specifically, Claim 16 now specifically recites that the method is computer-implemented, and that the nested object state transition diagrams are represented as data structures in the computer. It is repeatedly stated in the original specification that the present invention may be implemented as a CASE (Computer Aided Software Engineering) tool; see, for example, the last full paragraph of page 13. The foregoing recitation alone is believed to render the claim statutory subject matter, as it refers to a concrete representation of data structure within a physical computer.

The Office Action cites *In re Warmerdam* concerning the rejection under 35 U.S.C. § 101. *Warmerdam* is itself cited in the Federal Circuit's *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, which expressed at 47 USPQ2d 1596, 1601 (Fed. Cir. 1998) the test for statutory subject matter in this regard:

... For purpose of our analysis, as noted above, claim 1 is directed to a machine **programmed** with the Hub and Spoke software and admittedly produces a **"useful, concrete, and tangible result."** *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. This renders it statutory subject matter, **even if the useful result is expressed in numbers**, such as price, profit, percentage, cost, or loss. (emphasis added)

In the present case, Applicant's Claim 16 clearly produces the required "useful, concrete and tangible result" in its software-implemented ("programmed") determination of a complexity of graphs of state transitions. See Applicant's specification from page 10, line 3 through page 14, line 12 (and FIGS. 12-14) for a non-limiting disclosure of the analysis of state transition diagrams. FIG. 16 shows how the STDLCM (State Transition Diagram Logical Complexity Metric) computing method of FIG. 14 may be used in the broader context of a suite of software metrics. Clearly, the result of the invention is useful, concrete and tangible, as required.

Accordingly, it is believed to be clear that Applicant's Claim 16, and therefore all dependent Claims 17-21, are not merely directed to manipulation of abstract concepts, but operate in a concrete computer on data structures that provide a useful, concrete and tangible result. Accordingly, Applicant's claims are submitted to be directed to allowable subject matter, and reconsideration and withdrawal of the § 101 rejection are respectfully requested.

Rejection under 35 U.S.C. § 112, ¶ 2; Objection to Claim 17

The examiner has rejected Claims 16-21 as being indefinite, listing several items that are perceived to lack antecedent basis.

Applicant amends the claims to comply with the examiner's rejection of Claims 16-21 and objection to Claim 17. The objectionable phrase "1 is the first level object" is in Claim 22 which is canceled as being directed to a non-elected invention, thus rendering that portion of the rejection moot. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, ¶ 2 and the objection to Claim 17 are respectfully requested.

Response to Restriction Requirement

The new examiner appears to repeat, and perhaps implicitly finalize) the earlier examiner's restriction requirement, requiring a repeated election. Again, Applicant elects *Claim Set III: Claims 16-21*. Claims 1-15 and 22 are canceled without prejudice or disclaimer. Withdrawal of the restriction requirement is respectfully requested.

Formal Drawings

Applicant requests that the examiner affirmatively indicate acceptance of the formal drawings previously submitted in this case.

Change of Correspondence Address; New Associate Attorney


Supplemental to the "Revocation of Associate Power and Appointment of Attorney and Change of Correspondence Address" filed on August 25, 2004, which was apparently disregarded by the PTO, another Notice of Change of Address accompanies this Amendment so that future communications will be sent to the address associated with Customer No. 26,652.

Conclusion

All objections and rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

By: 

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